

II. Claim Rejections

Claims 1-16 and 25-34 (as renumbered) have initially been rejected either under 35 USC 102(b) or 35 USC 103(a) as being anticipated by and/or obvious over *Walsh* or *Walsh* in view of *Stone*. A careful review of the teachings of these patents, and of *Walsh* in particular, as detailed below, reveals that they do not, either alone or in combination, teach or make obvious the claimed invention in the present application. The claims are therefore allowable over these references in light of the following.

III. Legal Standards

a. 102 Anticipation

In order to anticipate a claim under §102(b), a reference must contain all of the essential elements of the claim. “[A]n anticipation rejection requires a showing that each limitation of a claim must be found in a single reference, practice, or device.” *In re Donohue*, 766 F.2d 531, 226 USPQ 619, 621 (Fed. Cir. 1985). “It is axiomatic that for prior art to anticipate under §102, it has to meet every element of the claimed invention.” *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 231 USPQ 81, 90 (Fed. Cir. 1986). Accordingly, for a rejection under §102, a cited reference is required to show

every element of any claim(s) rejected thereupon. MPEP §706.02(a).

b. 103 Obviousness

The determination of obviousness under 35 U.S.C. § 103 is a legal conclusion based on factual evidence. *Burlington Indus., Inc. v. Quigg*, 822 F.2d 1581, 1584, 3 U.S.P.Q.2d 1436, 1439 (Fed. Cir. 1987). Initially, the PTO bears the burden of establishing the *prima facie* case of obviousness. *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed Cir. 1984). To establish a *prima facie* case, the PTO must satisfy three requirements. First, the prior art relied upon, coupled with the knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or to combine references. *In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). Second, the proposed modification of the prior art must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. *Amgen, Inc. v. Chugai Pharm. Co.*, 927 F.2d 1200, 1209, 18 U.S.P.Q.2d 1016, 1023 (Fed. Cir. 1991). Lastly, the prior art reference or combination of references must teach or suggest all the limitations of the claims. See *In re Wilson*, 424 F.2d 1382,

1385, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970). To support a conclusion of obviousness, "either the references must expressly or impliedly suggest the claimed combination or the [PTO] must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. & Int. 1985). In evaluating obviousness, the Federal Circuit stated that one must look to see if "the prior art would have suggested to one of ordinary skill in the art that this process should be carried out and would have had a reasonable likelihood of success viewed in light of the prior art." *In re Dow Chemical Co. v. American Cyanamid Co.*, 837 F.2d 469, 473, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988). Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure." *Id.*

Neither the legal standard for a finding of anticipation under 35 USC 102(b) nor a finding of obviousness under 35 USC 103(a) are met by the Official Action in the present case.

DISCUSSION

The *Walsh* patent admittedly is a bit obscure in its disclosure and requires a careful reading to ascertain its teachings. However, upon careful inspection, it becomes clear

that *Walsh* teaches a method of forming carton blanks that are used to erect cartons having an integral fluid impervious lining. Such cartons are common, for example, in the cereal box industry where the lining contains the cereal and helps to preserve its freshness by inhibiting moisture migration into the box. *Walsh* is not exactly clear in this regard; however, a review of a related one of Mr. *Walsh*'s patent applications, U. S. published patent application Pub. No. US 2001/0022211 A1 (the '211 publication, copy attached) is instructive. Specifically, Figs. 2-4 of the '211 publication and the discussion thereof beginning at paragraph 0046 makes clear that the type of carton blank disclosed in *Walsh* is used to form a carton with a fluid impervious liner that can be filled with cereal, closed, and sealed, whereupon the box flaps can be closed over the sealed liner for product distribution.

Walsh ('871) discloses a method of forming blanks for erecting such lined boxes or containers. More specifically, *Walsh* teaches that a continuous web 2 of relatively rigid material (e.g. paperboard) is advanced along a path. This paperboard will become the outer box of the lined container. At the same time, a flexible fluid impervious material 10 (e.g. wax paper), which ultimately will form the liner, is drawn from a roll 12, receives a coating of adhesive 22, and is laminated or glued to the advancing web of rigid paperboard on a side that

will become the inside of an erected container. The resulting laminated web is then cut into individual carton blanks and scored to form fold lines that define the various panels of the blank. The bulk of the *Walsh* disclosure is concerned with the process of cutting the blanks so that certain cut lines that define, for example, the top and bottom flaps of the box extend through the rigid paperboard material but do not cut through the flexible fluid impervious liner material. This is important because the top of the liner must remain intact to be filled, closed, and sealed when the box is erected for use (see Figs. 2-4 of the '211 publication).

It is, of course, also important when forming lined containers in this way that the fluid impervious liner material not be adhered or glued to the flaps that will form the top of the box when the liner material is laminated to the web of paperboard. Otherwise, the top of the liner could not be separately closed and sealed after filling the box with cereal or other product. *Walsh* refers to this at Col 1, line 14 where he states that "in some instances, the continuous web of material is a laminate of a paperboard material and a fluid impervious material and wherein the fluid impervious material is not secured to the paperboard material at locations for forming top and bottom panel portions." (Emphasis added). *Walsh* teaches two ways to assure that this condition is met in the laminating

process. The first, illustrated in Fig. 4 of *Walsh*, is simply to apply adhesive to the fluid impervious web in strips so as to form voids or gaps 38 in the adhesive in regions of the paperboard web that will become the top and bottom flaps of the box.

Another method of accomplishing this same goal without the need to apply adhesive in strips is illustrated in Fig. 3 of *Walsh* and discussed in some detail at various locations in the specification. In this embodiment, strips 6 of flexible material (e.g. Kraft paper) are sandwiched between the paperboard web 2 and the fluid impervious web 10 in regions that ultimately will become the top and bottom flaps of completed carton blanks. *These strips are not adhered to paperboard web.* Instead, they form masks that prevent the web of fluid impervious material from sticking to the paperboard in regions where the strips are located. Thus, the fluid impervious sheet is laminated or adhered to the paperboard except in regions corresponding to the top and bottom flaps of the blank, where it is adhered only to the masking strips. Accordingly, when the lined box is erected from a blank, the top end of the liner is free to be filled, closed, and sealed before the box flaps are secured shut.

From the forgoing discussion and a careful review of the *Walsh* references, it becomes clear that the strips 6 are not

reinforcing strips as all. First, they are formed of a flexible material such as Kraft paper that has little if any reinforcing properties. Second, and most important, the strips 6 are not adhered to the paperboard and therefore cannot function to reinforce the paperboard. In fact, the very purpose of the strips is insure that the liner material is free from and does not stick to the paperboard in the regions of the box top and bottom. In such a configuration, the strips cannot possibly provide reinforcement. Finally, to adhere the strips 6 to the paperboard in *Walsh* would destroy the very purpose for which they are employed - to prevent the liner from adhering to the paperboard in these regions. Accordingly, *Walsh* teaches away from applying the strips in such a way that they might, even arguably, provide any reinforcement to the box once erected.

In stark contrast to the teachings of *Walsh*, applicant's invention, as claimed in claim 1 is a method of making reinforced paperboard cartons. The method comprises the steps of advancing a web of paperboard along a path, progressively applying and adhering at least one ribbon of reinforcing material to the advancing web of paperboard, cutting the web of paperboard to form carton blanks having panel portions, and forming the carton blanks into cartons, the ribbon of reinforcing material providing reinforcement in selected panel portions of the cartons. Unlike the teachings of *Walsh*, which

requires that the strips *not* be adhered to the paperboard, Applicant's claimed invention specifically recites that the strips are applied and adhered to the paperboard. Accordingly, *Walsh* not only fails to teach all of the steps of the claimed invention, it actually teaches just the opposite, at least with regard to the key step of adhering reinforcing strips to the paperboard web. Thus, the rejection of claim 1 under 35 USC 102(b) fails to meet the legal standard for anticipation and should be withdrawn.

Claims 2-16 depend from and include the limitations of claim 1. Therefore, these claims also are allowable over the cited art. With respect to certain specific claims, claim 2 recites that the ribbon of reinforcing material adhered to the web is paperboard, which itself is rigid and provides reinforcement. This is diametrically opposed to *Walsh*, which teaches that the masking strips and "relatively flexible material." As mentioned above, such a material is required in *Walsh* because it will become part of the mouth of the liner and must be thin and flexible for the liner to be closed and sealed. Claim 3 recites the steps of applying adhesive to the reinforcing strips and progressively bringing the strips into engagement with the advancing web of paperboard, thereby adhering the strips to the paperboard. This again is opposed to

Walsh, which requires that the strips *not* be adhered to the paperboard. And so it goes.

Independent claim 25 (renumbered) likewise recites a method of making paperboard carton blanks comprising the steps of advancing a web of paperboard along a path, laminating a ribbon of reinforcing material to the advancing web of paperboard, and cutting the web of paperboard and laminated ribbon into carton blanks, the laminated ribbon forming a layer of reinforcement in a panel portion of the carton blanks. *Walsh* fails to teach the step of laminating a strip of reinforcing material to the web of paperboard and teaches instead the intentional non-lamination of flexible strips to prevent the lining material from adhering to the paperboard in the regions of the top and bottom lids of the blank. *Walsh* is not concerned with reinforcement at all but rather in masking a portion of the web so that a liner will not stick to the web in that portion. Claim 25 is directed to a process that requires the lamination of reinforcing strips to the paperboard web, a step that would specifically defeat the stated purpose of the strips in *Walsh*.

Claims 26-34 (renumbered) depend from independent claim 25 (renumbered) and thus are allowable for at least the same reasons that claim 25 is allowable.

Regarding claim rejections under 35 USC 103(a), it is noted that *Walsh* is the primary reference in all such rejections. Thus, applicant submits that these claims are allowable in view of the forgoing discussion of *Walsh* and its failure to teach key elements of the claimed invention. Even if *Walsh* did teach these elements (which it does not), a combination of *Walsh* and *Stone*, the secondary reference, would not render the claimed invention obvious. *Stone* teaches a method of making a paperboard container with a lid or flip-up top. A collar 24 extends around the inside of the open top rim of the container and the flip top closes over the collar, which aligns and supports the flip top. In order to serve these purposes, the collar is a stiff rigid piece of material. As stated in Column 4 line 48 of *Stone*, "the collar material is preferably either paperboard, thick paper (e.g. 60 pound paper), or flexible plastic." Furthermore, the collar is press bonded to the carton material around the inside of the open top using an adhesive such as glue (see *Stone* at column 4, line 58).

In contrast to the rigid thick material of the collar taught by *Stone*, *Walsh* requires masking strips that are made of flexible material such as Kraft paper. This is because the strips will become part of the top of the liner when the container is erected and thus must be flexible so that the top of the liner can be closed and sealed after the container is

filled. Thus, to substitute thick paper or plastic as taught by Stone would render the *Walsh* carton unusable because the top of the liner would never close and seal. Furthermore, a fundamental requirement of *Walsh* is that the masking strips not be adhered to the paperboard material that forms the carton because their purpose is to insure that the liner material does not become attached to the top flaps of the blank. *Stone* teaches that the collar is press bonded with adhesive to the paperboard of the box. It would not be obvious to substitute the teachings of *Stone* because to bond the strips to the box material as taught by *Stone* would ruin the *Walsh* container. Finally, in a more general sense, it is submitted that one of ordinary skill in the art knowing about the lined carton blank of *Walsh* and the flip-top box of *Stone* simply would not conceive of the claimed method of the present application, since neither of these patents has anything to do with reinforcing selected panels of a carton. The only way that such a tenuous connection can even arguably be made is through improper hindsight gleened from foreknowledge of Applicant's own invention. However, It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992)

In summary, claims 1-16 and 25-34 (renumbered) recite a method of making reinforced paperboard cartons having unique steps and attributes not taught or suggested by the art of record. Accordingly, these claims are in condition of allowance and an early notice to such effect is earnestly solicited.

Respectfully submitted,



Steven D. Kerr
Reg. No. 32,472
Attorney for Applicant(s)

Womble Carlyle Sandridge & Rice PLLC
P. O. Box 7037
Atlanta, Georgia 30357-0037
Phone: (404) 962-7524
Fax: (404) 870-8174
Email: sdkerr@wCSR.com

I hereby certify that on the below entered date, this document was deposited in the United States Mail, postage prepaid, in an envelope addressed to Assistant Commissioner of Patents, Box Amendment, Washington D.C. 20231.

March 21, 2002
Date

Cheney West
Signature

EXHIBIT A

**MARKED-UP VERSIONS OF
REWRITTEN CLAIMS**

1. (Amended) A method of making reinforced paperboard cartons comprising the steps of:
 - (a) advancing a web of paperboard along a path, the web of paperboard having a width;
 - (b) progressively applying and adhering at least one ribbon of reinforcing material to the advancing web of paperboard, the ribbon having a width less than the width of the web of paperboard;
 - (c) cutting the web of paperboard to form carton blanks having panel portions; and
 - (d) forming the carton blanks into cartons for receiving articles, the ribbon of reinforcing material providing reinforcement in selected panel portions of the cartons.

5. (Amended) A method of making reinforced paperboard cartons as claimed in claim 4 and wherein the web of paperboard has opposed edge portions and wherein at least one of the plurality of ribbons of reinforcing material is applied and adhered along each edge portion of the web of paperboard.

6. (Amended) A method of making reinforced paperboard cartons as claimed in claim 4 and wherein step (b) further comprises applying and adhering a first ribbon of reinforcing material to said web of paperboard and applying and adhering a

second ribbon of reinforcing material to the first ribbon of reinforcing material to form a double thickness of reinforcing material on the web.

7. (Amended) A method of making reinforced paperboard cartons as claimed in claim 4 and wherein the web of paperboard has opposed edges and wherein at least one of the ribbons of reinforcing material is applied and adhered intermediate the opposed edges of the web.

8. (Amended) A method of making reinforced paperboard cartons as claimed in claim 1 and where in step (b) the at least one ribbon of reinforcing material is applied and adhered at a predetermined location across the width of the paperboard web to provide reinforcement only in a selected [region] panel portion of the cartons formed in step (d).

9. (Amended) A method of making reinforced paperboard cartons as claimed in claim 1 and further comprising the step of printing indicia on the at least one ribbon of reinforcing material, the indicia being visible from the inside of cartons formed in step (d).

10. (Amended) A method of making reinforced paperboard cartons as claimed in claim 9 and wherein the indicia is printed on the at least one ribbon of reinforcing material before the ribbon is applied and adhered to the web of paperboard in step (b).

25. (Amended) A method of making paperboard carton blanks comprising the steps of:

(a) advancing a web of paperboard along a path, the web of paperboard having a width;

(b) laminating a ribbon of reinforcing material to the advancing web of paperboard, the ribbon having a width less than the width of the web of paperboard and being positioned at a predetermined location on the web of paperboard; and

(c) cutting the web of paperboard and laminated ribbon into carton blanks of a predetermined size and configuration, the carton blanks defining panel portions and the laminated ribbon forming a layer of reinforcement in [a selection region] at least one panel portion of each of the carton blanks.

26. (Amended) A method of making paperboard carton blanks as claimed in claim [26] 25 and where in step (b) the ribbon of reinforcing material is a ribbon of paperboard.

27. (Amended) A method of making paperboard carton blanks as claimed in claim [27] 26 and wherein the ribbon of paperboard is paperboard trim.

28. (Amended) A method of making paperboard carton blanks as claimed in claim [27] 26 and wherein the ribbon of paperboard is paperboard cull.

29. (Amended) A method of making paperboard carton blanks as claimed in claim [26] 25 and wherein step (b) comprises advancing the ribbon of reinforcing material along a path, applying adhesive to the ribbon of reinforcing material, and bringing the ribbon into contact with the web to adhere the ribbon to the web.

30. (Amended) A method of making paperboard carton blanks as claimed in claim [26] 25 and wherein step (b) comprises laminating more than one ribbon of reinforcing material to the advancing web of paperboard, each ribbon having a width less than the width of the web of paperboard and being positioned at respective predetermined locations on the web of paperboard to provide reinforcement in selected panel portions of the blank.

31. (Amended) A method of making paperboard carton blanks as claimed in claim [31] 30 and wherein the web of paperboard has opposed edges and wherein at least one of the ribbons of reinforcing material is applied along an edge of the web of paperboard.

32. (Amended) A method of making paperboard carton blanks as claimed in claim [31] 30 and wherein the web of paperboard has opposed edges and wherein at least one of the ribbons of reinforcing material is applied at a location intermediate the edges of the web of paperboard.

33. (Amended) A method of making paperboard carton blanks as claimed in claim [31] 30 and wherein at least one of the ribbons of reinforcing material is applied atop another one of the ribbons of reinforcing material to form multiple layers of reinforcing material on said web of paperboard.

34. (Amended) A paperboard carton blank made by the process of claim [26] 25.